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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,504	05/04/2001	William Donovan Quigg	33582-8001US1	8692

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EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/849,504

Applicant(s)

QUIGG, WILLIAM DONOVAN

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 and 49-64 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-47 and 49-64 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-47 and 49-64 have been examined. Application 09/849,504 has a filing date 05/04/2001 Claims Priority from Provisional Application 60/202,583 (05/09/2000).

#### ***Response to Amendment***

2. In response to an Examiner Interview (02/22/05), the Examiner agreed that Zorn did not teach the Applicant's claimed invention. In response to said Examiner Interview the Applicant filed an Amendment on 03/07/2005, which amended claims 34-47 and cancel claim 48. Applicant amendment overcame the Section 101 rejection for claims 34-47 but did not overcome Section 101 for claims 49-64.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 49-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

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subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of providing paper products with promotional materials.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 49-64 are deemed to be directed to non statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 14, 16-18, 20-45, 49 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Villemure (US 5,938,036) in view of Zorn (US 6,129,346) and further in view of Wilen (US 5,407,233) and Pintsov (US 5,367,450).

A computer system for processing a paper product, comprising:

a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer, the paper product including a roll of paper or a plurality of unbound, stacked paper sheets (see column 1, lines 19-50);

Villemure fails to teach a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product or in an enclosure for the paper product and a paper product tracker configured to provide instructions for creating an enclosure for the paper product, the enclosure having or enclosing the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities; and the third-party advertiser pays to have the promotional material placed on or enclosed by the enclosure of the paper product. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order

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stack of papers using the Villemure system and advertisers would insert into said stack of papers said advertisers' promotions, as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into Villemure's stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claims 2, 14, 16, 18, 20-23, 26, 27, 31, 32, 34-39, 49, 52-54, 58-59 and 62-63, Villemure teaches:

The computer system of claim 1, but fails to teach further comprising a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material and tracking receipt of remuneration from the paper purchaser for the paper product. However, Zorn teaches a system that tracks remuneration paid by third party advertisers (i.e. business) and receipt of remuneration from the paper purchaser (i.e. subscriber; see column 6, lines 10-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Zorn system tracks the effectiveness of the advertisers' promotional material inserted into paper products (see column 6, lines 15-30), then, it would also track and bill the advertisers that are benefiting from inserting their promotional materials in a plurality of unbound, stacked paper sheets, as taught by Villemure.

As per claim 3 Villemure teaches:

The computer system of claim 1, but fails to teach further comprising an artwork tracker configured to provide instructions for creating a fixed medium that includes the

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promotional material. Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Villemure would use the Wilen's system to create enclosures into unbound paper sheets, which said enclosures would be used by advertisers to insert promotions into said paper products, as taught by Pintsov (see column 6, lines 20-50). The paper sheets' enclosures would help better secure said promotions to said paper sheets because said promotions would not easily detach from said paper sheets.

As per claims 4, 30 and 51, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to coordinate enclosing the paper product with a particular enclosure based on the content of the promotional material, the identity of the paper purchaser, and/or a location to which the paper product is to be delivered. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order stack of

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papers using the Villemure system and advertisers would insert into said stack of papers said advertisers' promotions, as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into Villemure's stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claim 5, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotional material order is a first promotional material order for first promotional material and the third-party advertiser is a first third-party advertiser, and wherein the promotions order tracker is configured to receive a second promotional material order from a second third-party advertiser to place second promotional material on the enclosure. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order stack of papers using the Villemure system and a plurality of advertisers would request to insert into said stack of papers said advertisers' promotions, as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into Villemure's



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stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claim 6, Villemure teaches:

The computer system of claim 1 wherein the product order tracker is configured to receive a paper product order for unbound, stacked sheets of paper and/or a roll of paper (see column 2, line 50 – column 3, line 52).

As per claim 7, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose unbound stacked sheets of paper. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order stack of papers using the Villemure system and advertisers would insert into wrappers of said stack of papers (see Villemure figure 4) said advertisers' promotions, as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into the wrappers

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of stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claims 8, 24, 28, 42 and 56, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order stack or rolls of papers using the Villemure system and advertisers would insert into wrappers of said stack or roll of papers (see Villemure figure 4) said advertisers' promotions, as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into the wrappers of roll of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claim 9, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to receive an order for an advertisement placed on a box

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configured to enclose the paper product. However, Pintsov teaches a system where third party advertisers pay to insert advertisements into mail pieces and where said inserted advertisements are targeted to customers based upon said customers' demographic profile (see Pintsov column 3, lines 1-5; column 6, lines 30-50). Wilen teaches the creation of mail pieces' enclosures, where said enclosures are used to attach information to said mail pieces (see figure 3). Zorn teaches a system that tracks advertisements inserted into mail pieces (see column 6, lines 9-23). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that paper purchaser would order stack of papers using the Villemure system and advertisers would insert advertisements into boxes of said stack of papers (see Villemure figure 3), as taught by Pintsov and Zorn. Advertisers would be more than willing to insert their advertisements into a box of a stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claims 10, 25, 33, 41, 55, 60 and 64, Villemure teaches:

The computer system of claim 1 but fails to teach wherein the promotions order tracker is configured to receive an order for a coupon placed on or enclosed by the enclosure. However Zorn teaches a system where advertisers pay to have coupons inserted into paper products (see column 6, lines 9-35). Therefore, It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Zorn system tracks the effectiveness of the advertisers' promotional material placed within the pages of publishers' printed publications (see column 6, lines 15-30), then, it would also track and bill the advertisers that are benefiting from inserting

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their coupons in a plurality of unbound, stacked paper sheets (see Villemure figure 4). Advertisers would be more than willing to insert their coupons into the enclosures of a stack of papers, as said insertion would help said advertisers save in mailing charges of said advertisements.

As per claim 17, Villemure teaches:

The method of claim 11, but fails to teach further comprising tracking receipt of remuneration from the paper purchaser to an intermediate party for the paper product. However, Zorn teaches a system that tracks remuneration paid by third party advertisers (i.e. business) and receipt of remuneration from the paper purchaser (i.e. subscriber; see column 6, lines 10-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Zorn system tracks the effectiveness of the advertisers' promotional material placed within the pages of publishers' printed publications (see column 6, lines 15-30), then, it would also track and bill the advertisers that are benefiting from inserting their promotional materials in a plurality of unbound, stacked paper sheets (see Villemure figure 3).

As per claim 40, Villemure teaches:

The method of claim 34 but fails to teach wherein providing instructions for disposing promotional material includes providing instructions for printing an advertisement on an external surface of the enclosure. However, Zorn teaches the printing of an advertisement into an external surface of an enclosure (see figure 1c). Therefore, it would have been obvious to a person of ordinary skill in the art at the time

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the application was made, to know that Villemure would print advertisements target to a demographic profile (see Pintsov column 6, lines 20-50) in the wrapper of a stack of papers (see Villemure figure 3). This feature would help advertisers save in mailing charges, as advertisements printed into an external surface of a enclosure would not increase the shipping cost of mailing said enclosure.

Claims 12, 13, 15, 19, 46, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Villemure (US 5,938,036) in view of Zorn (US 6,129,346) and further in view of Wilen (US 5,407,233) and Pintsov (US 5,367,450) and Loeb (US 6,421,652).

As per claims 12, 13, 15, 19, 46, 47 and 50, Villemure teaches:

The method of claim 11 but fails to teach wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or a third-party advertiser and tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material. However, Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Villemure would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

***Response to Arguments***

5. Applicant's arguments made in telephone Interview, filed 03/21/2005, with respect to the rejection(s) of claim(s) 1-64 under Zorn have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Villemure, Wilen, Zorn, Loeb and Pintsov.

The Applicant argues that claims 49-64 are statutory. The Examiner answers that the method step claims of 49-64 can be done without the use of a computer and are as a whole not within the technological arts and therefore, are non statutory.

***Conclusion***

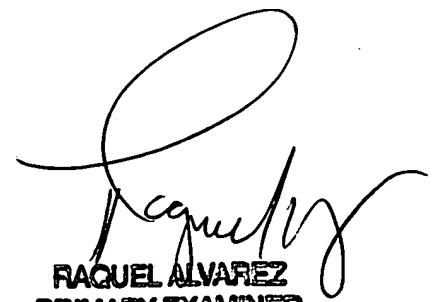
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The RightFax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
May 14, 2005

  
**RAQUEL ALVAREZ  
PRIMARY EXAMINER**